



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,867	03/04/2002	Hiroaki Sato	00449.00012	3965

22907 7590 07/15/2005

BANNER & WITCOFF
1001 G STREET N W
SUITE 1100
WASHINGTON, DC 20001

EXAMINER

GENACK, MATTHEW W

ART UNIT PAPER NUMBER

2645

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/086,867

Applicant(s)

SATO, HIROAKI

Examiner

Matthew W. Genack

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 26-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 26-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 3 recites the phrase "wherein the storage unit" in Line 1. There is insufficient antecedent basis for this limitation in the claim. Examiner interprets Claim 3 such that this phrase is replaced with the phrase "wherein the memory".
3. Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, due to the phrase "ignoring an incoming," in Line 2.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2, 26, 29, and 31-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Park *et. al.*, U.S. Patent No. 6,714,799.

Regarding Claim 1, Park *et. al.* discloses a system for enabling a subscriber of a GSM network to use his SIM card, associated with his GSM account, said GSM card mounted on a CDMA terminal that the user has in his possession during his time in an

Art Unit: 2645

area with a CDMA network, said CDMA network in communication with the user's GSM network for purposes including the verification of the user's subscriber information (Abstract, Column 2 Lines 6-12, Fig. 4). The CDMA terminal includes a SIM interface for interfacing between a controller, also located inside the CDMA terminal, and the mountable SIM card (Column 2 Lines 15-18, Column 4 Line 62 to Column 5 Line 3, Fig. 3). The CDMA terminal of the disclosed invention reads information unique to the subscriber from the SIM card, and enables said SIM card after verification has been received (Column 2 Lines 18-22). When a GSM subscriber inserts his SIM card into a CDMA terminal of the disclosed invention, an initialization procedure is started, wherein the controller detects the insertion of the SIM card, then prompts the user for a password, and (if the correct password is inputted) then reads a first set of information from the SIM card and transmits said set of information to the CDMA network (Column 6 Lines 17-45, Fig. 5). A second set of information, comprising information relating to the identity of the GSM subscriber, is sent back from the CDMA network (after interfacing with the GSM network) to the CDMA terminal's interface, and the CDMA terminal is enabled if the GSM user is verified, said verification being based on the two sets of information, and said CDMA terminal enablement procedure being inherent to a table in the CDMA terminal's memory wherein basic telephone functions are stored (Column 6 Line 46 to Column 7 Line 25, Column 7 Lines 46-65, Figs. 2 and 5-6).

Regarding Claim 31, it differs substantively from Claim 1 in that Claim 31 recites a time period for permitting the operation. This limitation reads on *Park et. al.* as follows: during the period in which the CDMA terminal with mounted SIM card is an

Art Unit: 2645

enabled state of operation, the user may register new telephone numbers; during registration, the controller is designed to wait for a given time period for an input (Column 10 Lines 36-49, Fig. 3).

Regarding Claim 2, Park *et. al.* discloses that both sets of information (traveling in opposite directions) comprise country code information (Column 6 Lines 33- 42, Column 7 Lines 20-25, Figs. 5-6).

Regarding Claim 26, Park *et. al.* discloses that the set of information transmitted from the SIM card mounted on the CDMA terminal comprises country code information associated with the network of the user's CDMA terminal-mounted SIM card (Column 6 Lines 33- 42, Fig. 5); the operation of enablement allows the user to make calls to or receive calls from one or more telephone numbers that may be stored in the CDMA terminal's memory (Column 10 Lines 60-65, Fig. 3).

Regarding Claim 29, Park *et. al.* discloses that the set of information transmitted from the SIM card mounted on the CDMA terminal comprises country code and home network code information associated with the user's CDMA terminal-mounted SIM card (Column 6 Lines 33- 42, Fig. 5).

Regarding Claim 32, during the enabled state of operation, it is inherent that the CDMA terminal with mounted SIM card may receive an incoming call.

Regarding Claim 33, Park *et. al.* discloses that the set of information transmitted from the SIM card mounted on the CDMA terminal comprises country code information associated with the network of the user's CDMA terminal-mounted SIM card (Column 6 Lines 33-42, Fig. 5).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Park *et. al.*

Park *et. al.* does not expressly disclose a memory that is a removably connected integrated circuit.

Examiner took official notice in the last Office Action that the use of integrated circuits in cellular telephone memories is well known in the art. Further, any integrated circuit is removably connected to the system in which it is used because it may be unsoldered and removed as needed. Applicant's lack of traverse to the officially noticed fact in the last Office Action is taken as an admission of the facts noticed.

Thus, it would have been obvious to one of ordinary skill in the art at the time that the invention was made to use an integrated circuit in the memory 34 (see Fig. 3) of the CDMA terminal. The modification is obvious since the use of integrated circuit chips is the current trend in the telecommunication industry.

8. Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park *et. al.* in view of Anvekar *et. al.*, U.S. Patent No. 6,684,072.

Park *et. al.* discloses the presence of a display in the CDMA terminal with mounted SIM card (Fig. 3).

Park *et. al.* does not expressly disclose the display of international roaming messages to indicate that a user is not in the country that his SIM card is registered in, nor the presence of caller ID features with the invention.

Anvekar *et. al.* discloses a global prepaid roaming service (Abstract, Column 1 Lines 39-49, Fig. 1). A cellular telephone using the disclosed invention keeps track of its own roaming status (Column 5 Line 36 to Column 6 Line 18, Fig. 7). Furthermore, Anvekar *et. al.* discloses the use of caller ID features with the roaming service of the disclosed invention (Column 7 Lines 32-38).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to modify the invention of Park *et. al.* by providing for the display of roaming status and caller ID information for the CDMA terminal with mounted SIM card.

One of ordinary skill in the art would have been motivated to make this modification because of the different conditions, such as cost and quality of service, that may apply for a user when he is roaming in another network, and because roaming status may have a bearing on whether or not a user would like to accept a given call.

9. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Park *et. al.* in view of Link, II *et. al.*, U.S. Patent No. 6,334,054, further in view of Haas *et. al.*, U.S. Patent No. 6,615,036.

Park *et. al.* discloses every limitation of Claim 1, upon which Claim 30 depends, as outlined above.

Park *et. al.* does not expressly disclose that, while enabled, the CDMA terminal with mounted SIM card may do any one of the following: accept an incoming call, ignore an incoming call, forward an incoming call to a voice mail service, and recording a voice mail on the CDMA terminal with mounted SIM card.

Link, II *et. al.* discloses a wireless telephone that may accept an incoming call, reject an incoming call, and forward an incoming call to a voice mail system (Column 3 Lines 4-15, Column 7 Lines 17-28, Fig. 6).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to modify the invention of Park *et. al.* by allowing the CDMA terminal with mounted SIM card in an enabled state of operation to accept an incoming call, ignore an incoming call, and forward an incoming call to a voice mail service.

One of ordinary skill in the art would have been motivated to make this modification because if a GSM user is enabled to use his account in a CDMA region, then it is natural that he would desire to use features that he is used to in his region.

Neither Park *et. al.* nor Link, II *et. al.* expressly discloses the practice of downloading and storing voice mail messages locally.

Hass *et. al.* discloses the practice of a remote unit in a cellular system downloading and storing a voice mail message locally (Abstract, Column 1 line 60 to Column 2 Line 5, Column 3 Lines 18-27, Fig. 1).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to modify the invention of Park *et. al.* as modified by Link, II *et. al.* by providing for the downloading of voice mail messages by the CDMA terminal with

Art Unit: 2645

mounted SIM card and storing said voice mail messages in said CDMA terminal with mounted SIM card.

One of ordinary skill in the art would have been motivated to make this modification because of convenience of having voice mail messages stored on one's cellular telephone, available for review at any time, regardless of the availability of cellular service.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew W. Genack whose telephone number is 703-605-4305. The examiner can normally be reached on FLEX.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 2645

Matthew Genack

Examiner

Art Unit 2645

Matthew Genack

1 July 2005

hw l f
ROUND 6. FOSTER
PRIMARY EXAMINER